

REMARKS

§103 rejections

In the 9 January 2008 Office Action, claims 25 – 40 and 49 - 61 are rejected under §103(a) as being unpatentable over U.S. Patent 5,991,758 (hereinafter Ellard) in view of U.S. Patent 5,999,908 (hereinafter, Abelow). The Office Action also mentions Lyons so that will be discussed as well. The Assignee respectfully traverses the §103 rejections of claims 25 – 40 and 49 - 61 in two ways. First, by noting that the rejections fail under both standards of the APA. Second, by noting that the cited combination of documents fails to establish a prima facie case of obviousness in a number of ways, including:

1. teaching away from the claimed invention,
2. requiring a change in the principle of operation of the cited invention in order to enable replication of claimed functions, and
3. failing to teach one or more limitation for every claim.

The Assignee also notes that there are still other ways in which all §103 obviousness rejections in the 9 January 2008 Office Action for claims 25 – 40 and 49 - 61 can be traversed. For example, the cited combination does not make the invention as a whole obvious, destroys the ability of at least one of the disclosed inventions to function and is not enabling.

As noted previously, the first way that the cited combination fails to establish a prima facie case of obviousness for claims 25 – 40 and 49 - 61 is that the documents in the cited combination fails to make the inventions as a whole obvious by teaching away from all claimed methods. MPEP § 2141.02 states that: *"in determining the difference between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious but whether the claimed invention as a whole would have been obvious."* An example of the documents in the cited combination teaching away from the claimed methods includes:

- Ellard teaches integration of data in accordance with a master entity index (Ellard, FIG. 1 and C2, L 40) and Lyons teaches storage of data in accordance with patterns related to a SEPT value. These patterns are developed and controlled by end users. Both of these teachings lead away from the claimed invention teaches data integration in accordance with a common xml model or schema.
- Abelow teaches a Customer Based Product Design (CBPD) System that collects and disseminates feedback from customers to support the development of new products.

The disclosed invention has no direct relevance to this application or any pending
Serial No: 10/645,099

application in the Assignee portfolio. Abelow does teach away from the claimed methods by teaching the development and use of an interactive community to identify the best method for managing new product sales and marketing. The claimed invention teaches the use of a detailed model of organization shareholder value to identify the best mode for managing all aspects of organization operations.

The Assignee notes that there are still other ways in which the documents in the cited combination teach away from the claimed methods.

The second way the 9 January 2008 Office Action fails to establish a prima facie case of obviousness for claims 25 – 40 and 49 - 61 is that the proposed modification would change the principle of operation of the inventions disclosed in the cited combination. MPEP 2143.01 provides that when “*the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)*”. Some of the changes in operating principle required to make the cited combination function are discussed below.

- Ellard teaches integration of data in accordance with a master entity index (Ellard, FIG. 1 and C2, L 40) while the claimed invention teaches integration in accordance with a common model or schema. Lyons teaches storage of data in accordance with patterns related to a SEPT value. Making a change to integrate data in accordance with a common model or schema would require the abandonment of the master entity index principle upon which the Ellard invention is based and/or the SEPT data storage principle upon which Lyons is based. Because a change in the principle of the operation of the Ellard invention and Lyon invention is required to enable the cited combination to replicate the functionality of the claimed invention, the teachings of the documents are not sufficient to render the claims prima facie obvious.

The Assignee notes that there are still other changes in the principle of operation of the inventions described by the cited documents that would be required to replicate the claimed invention.

The third way that the cited document fails to establish a prima facie case of obviousness for claims 25 – 40 and 49 - 61 is that the cited combination does not teach or suggest one or more of the limitations for every rejected claim. MPEP 2143.03 provides that: *to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art (In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974))*.

35 U.S.C. § 112 Second Paragraph Rejection of Claims

In the 9 January 2008 Office Action the Examiner has rejected claims 25, 33 and 57 are rejected under 35 U.S.C. §112 second paragraph. In particular, the Examiner feels that the terms: “using at least a portion of said data”, “metadata standard” and “disparate source” and renders the claims that incorporate them indefinite. The Assignee will respectfully traverses the §112 second paragraph rejections of each claim in five ways:

1. by noting that the claim rejections are moot because the claims have been amended;
2. by noting that the Office Action has failed to establish a prima facie case that the claims do not meet the requirements of §112 second paragraph;
3. by noting that the claim rejections based on assertions of alleged indefiniteness are not in compliance with the Administrative Procedures Act and are therefore moot;
4. by noting that the disclosure and/or prior art completely explains these allegedly indefinite terms; and
5. by noting that a different standard is being used for the review of the claims in the instant application than that used for the review of similar patents, an apparent violation of 35 USC 3.

The second way the Assignee will traverse the 35 U.S.C. §112 second paragraph rejection of claims 25, 33 and 57 will be by noting that the arguments presented by the Examiner fail to establish the prima facie case required to sustain a §112 second paragraph rejection. *MPEP 2173.02 states that: definiteness of claim language must be analyzed, not in a vacuum, but in light of:*

- (A) *The content of the particular application disclosure;*
- (B) *The teachings of the prior art; and*
- (C) *The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.*

In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of

the patent. See, e.g., Solomon v. Kimberly-Clark Corp., 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). See also In re Larsen, No. 01-1092 (Fed. Cir. May 9, 2001). In the case of claims 25, 33 and 57 the Examiner has failed to establish the prima facie case that the specification does not meet the requirements of §112 second paragraph in five ways for every rejected claim. The five ways are: by failing to interpret the claims in light of the specification, failing to interpret the claims in light of the prior art, by failing to provide any evidence that someone of average skill in the relevant arts would have difficulty interpreting the claims, by failing to establish that the limitation(s) in the claims fail to describe the invention and/or by failing to consider the claim as a whole.

As noted previously, the third way the Assignee will respectfully traverse the §112 second paragraph rejections of claims 25, 33 and 57 is by noting that the assertions regarding the alleged indefiniteness of the claims are not in compliance with the requirements of the Administrative Procedures Act and are therefore moot. In *Dickinson v. Zurko*, 119 S. Ct. 1816, 50 USPQ2d 1930 (1999), the Supreme Court held that the appropriate standard of review of PTO findings are the standards set forth in the Administrative Procedure Act ("APA") at 5 U.S.C. 706 (1994). The APA provides two standards for review – an arbitrary and capricious standard and a substantial evidence standard. The Assignee respectfully submits that discussion in the preceding paragraphs clearly shows that the instant Office Action fails to provide even a scintilla of evidence to support the allegation that the specification does not meet the requirements of §112 second paragraph and that as a result it fails to meet the substantial evidence standard. The Assignee respectfully submits that the 9 January 2008 Office Action also fails to pass the arbitrary and capricious test because the Examiner has not provided any evidence of relevant fact finding that can be connected to the rejections contained in the Office Action. In particular, the Assignee notes that the 9 January 2008 Office Action does not contain any declarations from individuals with the requisite skill in the art of data processing to support the assertions regarding the claims. The Assignee notes that there are still other ways in which these rejections can be shown to be arbitrary, capricious and discriminatory.

The fourth way the Assignee will traverse these claim rejections is by noting that the disclosure and prior art clearly explains the term "using at least a portion of said data", "metadata standard", "disparate source" and "for each aspect". In particular, the specification clearly explains the portion of the data that is being used, identifies the metadata standards being used, identifies the disparate sources of data and specifically lists the aspects of performance being analyzed.

The fifth way is by noting that the claims of the instant application is apparently being reviewed under a different standard than that used for the review of similar patents - an apparent violation of 35 USC 3. For example, there are over 500 patents that used the term "using at least a portion of the data". More specifically, IBM is allowed to use this term in its issued patents without providing an explanation as to which portion of data is being used (see for example U.S. Patent 6,246,672 and U.S. Patent 6,298,531). In a similar manner, "disparate source" is used in the claims of 11 patents including patents issued to Cisco, IBM and Mercedes (see for example U.S. Patent 7,177,822, U.S. Patent 6,675,350 and U.S. Patent 6,915,472) without providing any detail regarding the disparate sources of data. Finally, it is worth noting that metadata standard combines two well known words whose meaning is well known, the phrase is also mentioned in at least seven issued patents and those writing the specification for these patents did not feel the need to define the term which provides further evidence that its meaning is well known to those of average skill in the art. In short, the Examiner is questioning the use of certain terms in the claims in spite of the fact that the instant application provides as much or more explanation than that provided by larger companies for claims using these same terms in issued patents.

35 U.S.C. § 101 Rejection of Claims

In the 9 January 2008 Office Action claims 25, 33 and 57 are rejected under 35 U.S.C. §101 as being non-statutory subject matter. In particular, the Examiner asserts that the claims are directed abstract ideas because they include the words “integrating data”, “evolving”, “creating”, “generating” and “identifying”. The Assignee traverses these rejections in at least six ways:

1. by noting the claim rejections are moot because the claims have been amended;
2. because the Examiner has failed to establish a prima facie case of non-statutory subject matter for the rejected claims;
3. by noting the claimed inventions produce results that are concrete, tangible and useful;
4. by noting the claimed inventions transforms transaction data into a different state or thing;
5. by noting arguments regarding the alleged non-statutory subject matter fail to comply with the requirements of the Administrative Procedures Act and are therefore moot; and
6. by noting the subject matter eligibility of the instant application is apparently being reviewed under a different standard than that used for the review of similar patents, an apparent violation of 35 USC 3.

As mentioned above, the second reason claims 25, 33 and 57 are patentable is that the arguments presented by the Examiner fail to establish a prima facie case of non-statutory subject matter for the rejected claims. As noted in Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility “*the Examiner bears the initial burden ... of presenting a prima facie case of unpatentability.*” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The Assignee notes that the Examiner has made a general statement to the effect that because the claims recite terms such as “integrating data”, “evolving”, “creating”, “generating” and “identifying” they are abstract. However, the Examiner has not provided any evidence to support the fact that the claim taken as a whole is abstract and lack a specific utility. MPEP 2164.07 states “*the examiner has the initial burden of challenging an asserted utility. Only after the examiner has provided evidence showing that one of ordinary skill in the art would reasonably doubt the asserted utility does the burden shift to the applicant to provide rebuttal evidence sufficient to convince one of ordinary skill in the art of the invention's asserted utility.*” *In re Brana*, 51 F.3d 1560, 1566, 34 USPQ2d 1436, 1441 (Fed. Cir.

1995) (citing *In re Bundy*, 642 F.2d 430, 433, 209 USPQ 48, 51 (CCPA 1981)). Given the complete absence of evidence to support these assertions, the Assignee respectfully submits that the Examiner has failed to establish the required prima facie cause of non-statutory subject matter for the rejected claims.

The third reason the claims are patentable is that it is clear that - taken as a whole - the claimed inventions are: a method (claim 25), an article of manufacture (claim 33) and an article of manufacture (claim 57) that produce results that are concrete, tangible and useful. In particular, the invention of claim 25 produces a list of concrete changes for improving shareholder value, the invention of claim 33 produces clustering models for detailed analysis of enterprise financial performance and the invention of claim 57 produces an integrated database that supports the detailed analysis of enterprise financial performance.

The fourth reason the claims are patentable is that the claimed inventions represent a method (claim 25), an article of manufacture (claim 33) and an article of manufacture (claim 57) for transforming transaction data into a different state or thing. As noted in the *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility* "the Supreme Court noted that one example of a statutory "process" is where the process steps provide a transformation or reduction of an article to a different state or thing (*Diehr*, 450 U.S. at 183, 209 USPQ at 6). In *Alappat*, the Court held that "data, transformed by a machine" "to produce a smooth waveform display" "constituted a practical application of an abstract idea." *State Street*, 149 F.3d at 1373. In *Arrhythmia*, the Court held "the transformation of electrocardiograph signals" "by a machine" "constituted a practical application of an abstract idea." *Id.* Likewise, in *State Street*, the Court held that "the transformation of data" "by a machine" "into a final share price, constitutes a practical application of a mathematical algorithm." *Id.* Thus, while *Diehr* involved the transformation of a tangible object - curing synthetic rubber - the Court also regards the transformation of intangible subject matter to similarly be eligible, so long as data or signals represent some real world activity. It is the Assignee's understanding that the PTO views this "data transformation" test as an appropriate way to evaluate subject matter eligibility (see *In re Comiskey*, No. 2006- 1286).

The third and fourth reasons taken together make it clear that the claimed inventions pass the data transformation test and are: a method (claim 25), an article of manufacture (claim 33) and an article of manufacture (claim 57) that support practical applications with substantial, specific utility and are therefore statutory subject matter.

As stated previously, the fifth reason the claims are allowable is that the unsupported allegations used to support the claim rejections are not in compliance with the requirements of the Administrative Procedures Act and are therefore moot. In *Dickinson v. Zurko*, 119 S. Ct. 1816, 50 USPQ2d 1930 (1999), the Supreme Court held that the appropriate standard of review of U.S.P.T.O. findings of fact are the standards set forth in the Administrative Procedure Act ("APA") at 5 U.S.C. 706 (1994). The APA provides two standards for review – an arbitrary and capricious standard and a substantial evidence standard. The Supreme Court has defined substantial evidence as “substantial evidence is more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion. . . . Mere uncorroborated hearsay or rumor does not constitute substantial evidence. Consolidated, 305 U.S. at 229-30 (citations omitted)”. The Assignee respectfully submits that the instant Office Action fails to provide even a scintilla of evidence to support the allegation of non-statutory subject matter it contains and that as a result it fails to meet the substantial evidence standard. The Assignee respectfully submits that the arguments presented by the Examiner also fail to pass the arbitrary and capricious test. Under the arbitrary and capricious test a reviewing court analyzes only whether a rational connection exists between the agency's fact findings and its ultimate action, (see *Hyundai Elecs. Indus. Co. v. ITC*, 899 F.2d 1204, 1209, 14 USPQ2d 1396, 1400 (Fed. Cir. 1990)). The Assignee rejection of claims 25, 33 and 57 also fails to pass the arbitrary and capricious test because the Examiner has not completed any discernible fact finding that can be rationally or irrationally connected to the rejection contained of these claims.

As noted previously, the sixth reason 25, 33 and 57 are patentable is that the subject matter eligibility of the instant application is apparently being reviewed under a different standard than that used for the review of similar patents - an apparent violation of 35 USC 3. There are two examples of this apparent discrimination. First, as noted previously, the cited claims all pass the data transformation test which the U.S.P.T.O. has cited as an appropriate way to evaluate subject matter eligibility (see *Supplemental Letter Brief from James R. Toupin re: In re Comiskey, No. 2006- 1286*). Given this endorsement, it is not clear why the Examiner is attempting to use a different method to establish subject matter eligibility in an apparently discriminatory manner. Second, a review of the USPTO database shows that there are over 450,000 patents where the claims include one or more of the terms the Examiner has objected to. The Assignee only makes the comparison shown above to illustrate the point that the above referenced application is not being reviewed under the same standard for subject matter eligibility that has been used for the review and allowance of other patent applications.

Statement under 37 CFR 1.111

37 CFR 1.111 requires that the basis for amendments to the claims be pointed out after consideration of the references cited or the objections made. 37 CFR 1.111 states in part that:

In amending in response to a rejection of claims in an application or patent undergoing reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections.

The Assignee notes that this requirement is not relevant to the instant application because, as detailed above, there are no references or objections to avoid. Having said that, the Assignee notes that the primary reasons the claims were amended was to put the application in final form for allowance and issue. A summary of the amendments to independent claims is shown below.

Independent claim	Summary of amendment
49	Narrowed focus to predictive transform models
57	Use xml and a common schema where the schema incorporates a common data dictionary

Objections

The Assignee objects to this Office Action as being non-statutory. Under 35 USC 131 and other statutes the Assignee is entitled to an objective examination of this patent application that is conducted in accordance with prevailing statutes and established precedents by someone with knowledge of the relevant arts. It does not appear that any such examination has occurred. A prompt correction is respectfully requested.

Copending applications

Under the provisions of MPEP § 2001.06(b), the Examiner is hereby advised of the following co-pending U.S. Patent Application(s) which have claims pending that may be viewed as similar (with or without justification) to pending claims 25 – 32 of the instant application.

Application(s)	Pending claims that may viewed as being similar to claims 25 - 32	Summary of claims
09/764,068	36 – 63, 72 – 74 on appeal	Model of future or current enterprise market value by category of value, accounting
10/441,385	189 - 254	Element of value impact by category of value to market value or financial performance aspect
10/645,099	25 - 32	Element of value contribution by category of value to share price
10/746,673	all	Element of value contribution to segments of value

Applications 08/999,245, 09,761,670, 10/287,586 and 10/298,021 have claims related to element of value impact on a current operation. Application 10/097,344 has claims related to element of value impact on a current operation and to one or more real options. A copy of the most recent Office Actions and amendments for the above referenced applications are available on the U.S.P.T.O.'s Image File Wrapper so no material is attached hereto.

Under the provisions of MPEP § 2001.06(b), the Examiner is hereby advised of the following co-pending U.S. Patent Application(s) which have claims pending that may be viewed as similar (with or without justification) to pending claims 49 – 56 of the instant application.

Application(s)	Pending claims that may viewed as being similar to claims 49 - 56	Summary of claims
10/645,099	49 – 56	Using transform predictive models
10/743,417	125 - 150	Developing transform predictive models

A copy of the most recent Office Actions and amendments for the above referenced applications are available on the U.S.P.T.O.'s Image File Wrapper so no material is attached hereto.

Under the provisions of MPEP § 2001.06(b), the Examiner is hereby advised of the following co-pending U.S. Patent Application(s) which have claims pending that may be viewed as similar (with or without justification) to pending claims 57 – 59 of the instant application.

Application(s)	Pending claims that may viewed as being related to claims 57 - 59	Summary of claims
09/761,670	80 – 84 on appeal	Method for integrating data using common schema that includes common data dictionary
10/282,113	51 – 57 on appeal, others pending may be amended or cancelled	System for integrating data using common schema that includes common data dictionary
09/940,450	34 – 52 on appeal, others pending may be amended or cancelled	Integrate data using xml and a common schema that includes common data dictionary
10/645,099	57 – 59	Integrate data in using xml and a common schema that includes a common data dictionary
09/764,068	70 – 71 on appeal	Integrate data using xml and a common schema that includes a common data dictionary
10/441,385	186 – 188	Continuously integrate data using xml and a common schema that includes common data dictionary

A copy of the most recent Office Actions and amendments for the above referenced applications are available on the U.S.P.T.O.'s Image File Wrapper so no material is attached hereto.

Under the provisions of MPEP § 2001.06(b), the Examiner is hereby advised of the following co-pending U.S. Patent Application(s) which have claims pending that may be viewed as similar (with or without justification) to pending claims 60 - 62 of the instant application.

- a) application 10/717,026 (which just received a notice of allowance) and 11/279,104 (a continuation of 10/717,026) disclose a method for searching for relevant data, information and/or knowledge based on a subject entities context;
- b) application 11/094,171 discloses a method for searching for relevant data, information and/or knowledge based on the health context of a subject entity. It also supports search based on a predicted health context;
- c) application 11/262,146 and 11/268,081 had claims pending for query driven search based on an entity context. The query related claims in these applications were cancelled and application 12/114,784 for a Complete Context(tm) Query System now contains claims for query driven search based on an entity context.;
- d) application 11/358,196 discloses a method for delivering information when there is a match of an entity's context and a previously stored context and/or when a stored keyword is related to an upcoming decision that will be made by an entity; and

e) application 10/750,792 discloses a method for measuring the relevance of a keyword to an organization.

Reservation of rights

The Assignee hereby explicitly reserves the right to present the previously modified and/or canceled claims for re-examination in their original format. The cancellation or modification of pending claims to put the instant application in a final form for allowance and issue is not to be construed as a surrender of subject matters covered by the original claims before their cancellation or modification.

Conclusion

The pending claims are of a form and scope for allowance. Prompt notification thereof is respectfully requested.

Respectfully submitted,
Asset Trust, Inc.

/B.J. Bennett/

B.J. Bennett, President
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